

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FREDERICK M. AUSUBEL, LAURENCE G. RAHME,
MAN-WAH TAN, GARY B. RUVKUN, SHALINA MAHAJAN-MIKLOS,
ANNEGIEN BROEKS, RONALD H.A. PLASTERK,
GEORG JANDER, and JACQUELINE HEARD

Appeal No. 2003-0922
Application No. 08/962,750

ON BRIEF

Before SCHEINER, MILLS, and GRIMES, Administrative Patent Judges.

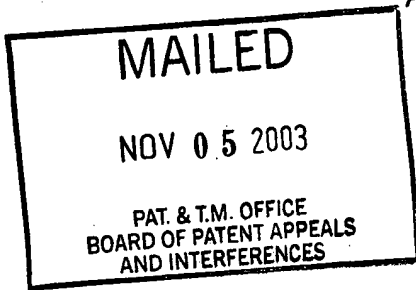
GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

The following matter must be addressed before we reach the merits of the
issue on appeal.

1. The after-final amendment

Concurrently with the Appeal Brief, Appellants filed a "Supplemental
Amendment," requesting amendment of claims 1, 18, 19, and 22. See Paper
No. 20, filed October 16, 2000. According to Appellants, the proffered
amendment "narrows the issues on appeal and expedites resolution of this case."



Appeal Brief (Paper No. 19), page 18. Appellants also asserted that the amendment "raises no issues requiring a new search." Id.

Appellants noted that the amendment, "with respect to claims 1 and 22, is identical to that submitted by appellants with their reply of April 14, 2000" (Paper No. 16). The examiner refused to enter the amendment requested in Paper No. 16. See Paper No. 18, mailed May 30, 2000. However, the examiner did not respond to Appellants' renewed request for entry of the amendment when it was presented with the Appeal Brief.

The examiner responded to the original Appeal Brief with a Notice of Defective Brief (Paper No. 21, mailed January 18, 2001). The brief was asserted to be defective on several grounds, but Paper No. 21 made no mention of the proffered amendment. Appellants responded with a new brief (Paper No. 22, filed February 15, 2001), that repeated their request for entry of the Supplemental Amendment. See pages 17-18.

The examiner did not mention the amendment in the Examiner's Answer. In their Reply Brief, Appellants again repeated their request for entry of the amendment. See Paper No. 24, filed November 12, 2002, pages 4 and 5-6. The examiner responded simply that the Reply Brief had been entered and considered. See Paper No. 25, mailed January 15, 2003.

The record does not make clear whether the examiner has entered Appellants' amendment. On one hand, the examiner did not expressly state that the amendment would be entered, either in the Examiner's Answer or in the response to the Reply Brief. This might be taken to mean the amendment was

denied entry sub silentio, since an amendment after final rejection is not entered as a matter of right. See 37 CFR § 1.116.

On the other hand, in responding to Appellants' arguments, the examiner stated that "[t]he claims . . . state a description of the pathogen as 'said same pathogen utilizing a common virulence factor to infect said eukaryotic organisms' and that a compound's inhibition or reduction of pathogenicity is 'a consequence of affecting the function of said common virulence factor in said pathogen.'" Examiner's Answer, page 7. The limitations quoted by the examiner are those that were requested in the amendment. Thus, this passage from the Examiner's Answer suggests that the examiner intended to enter the amendment.

Our review of the appealed rejection may be affected by the entry (or non-entry) of the amendment. The test of obviousness is whether the claimed "subject matter as a whole would have been obvious" in view of the prior art. 35 U.S.C. § 103. "The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). The additional limitations requested by Appellants in their Supplemental Amendment change the scope of the claimed method and may change whether those skilled in the art would have found it obvious in view of the cited references.

On return of this application, the examiner should clarify whether or not Appellants' amendment filed October 16, 2000 (Paper No. 20), has been entered. Entry of an amendment filed after a notice of appeal is not a matter of right, and the examiner should consider whether the proposed amendment

complies with 37 CFR § 1.116. See Manual of Patent Examining Procedure § 1207. If the examiner refuses to enter the proposed amendment, and Appellants seek review of that decision, review must be had by way of petition, not appeal. See 37 CFR § 1.127.

2. Future proceedings in this application

We are not authorizing entry of a Supplemental Examiner's Answer. If the examiner decides that Appellants' amendments should be entered but do not put the claims in condition for allowance, reopening prosecution may be necessary. Appellants must be given a full and fair opportunity to respond to any ground of rejection in a future communication.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED



TONI R. SCHEINER
Administrative Patent Judge



DEMETRA J. MILLS
Administrative Patent Judge



ERIC GRIMES
Administrative Patent Judge

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